

**REMARKS**

The Office Action of May 15, 2003 presents the examination of claims 34, 41-42, 48-52, and 56-61. Claim 34 is allowed. Claims 41-42, 51-52, 56-57, and 60-61 are canceled herein. Claim 48 is amended to depend from allowed claim 34 only. Claims 58 and 59 are amended into independent form. Support for the amendments to claims 58 and 59 is found in canceled claims 41 and 42, respectively, and in the specification on pages 54-55 (Example 4). Claims 62 and 63 are added. Support for these claims is found in the specification on pages 54-55 (Example 4). No new matter is inserted into the application.

***Interview***

An interview was held with the Examiner and Supervisory Examiner at the United States Patent and Trademark Office on September 10, 2003. A second telephonic interview was held with the Examiner on November 13, 2003. The assistance of the Examiner and Supervisory Examiner in advancing prosecution of the present application is appreciated.

***Rejection under 35 U.S.C. § 112, first paragraph***

**Written Description**

Claims 41-42, 48-50, 56-57 and 60-61 are rejected under 35 U.S.C. § 112, first paragraph, for an alleged lack of written

description of the invention in the specification.

Claims 41-42, 56-57, and 60-61 are canceled, thus rendering rejection thereof moot. It should be noted that Applicants do not acquiesce that the canceled claims fail to meet the requirements of 35 U.S.C. § 112, first paragraph. However, these claims are canceled in order to obtain immediate allowance of the present application.

Applicants respectfully traverse the rejection of claims 48-50. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested. Claim 48 is amended to depend from allowed claim 34 only. Claim 49 depends from claim 48, and claim 50 depends from claim 49. As discussed with the Examiner on November 13, 2003, these claims are now in condition for allowance.

Applicants respectfully submit that the rejection under 35 U.S.C. § 112, first paragraph, written description is overcome. Accordingly, withdrawal thereof is respectfully requested.

#### Enablement

Claims 41-42, 48-50, and 56-61 are rejected under 35 U.S.C. § 112, first paragraph for allegedly not being enabled by the specification.

Claims 41-42, 56-57, and 60-61 are canceled, thus rendering rejection thereof moot. It should be noted that Applicants do not acquiesce that the canceled claims fail to meet the requirements of

35 U.S.C. § 112, first paragraph. However, these claims are canceled in order to obtain immediate allowance of the present application.

Applicants respectfully traverse the rejection of claims 48-50 and 58-59. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

Claim 48 is amended to depend from allowed claim 34 only. Claim 49 depends from claim 48, and claim 50 depends from claim 49. Applicants respectfully submit that these claims are in condition for allowance. As discussed with the Examiner on November 13, 2003, these claims are now in condition for allowance.

Claims 58 and 59 are amended into independent form. In the interview of November 13, 2003, the Examiner took a position that, as SEQ ID NO: 5 and SEQ ID NO: 10 describe only partial sequences of a Semaphorin W gene, they were not considered functional. Applicants point out that the language of claims 58 and 59 uses the transitional term, "comprising", and thus the claims are open to addition of nucleotides to either end of the specific polynucleotides of SEQ ID NO:10 and SEQ ID NO:5. Such additional nucleotides would encode the additional amino acids the Examiner asserts are required to produce a functional Semaphorin W protein. The Examiner is further reminded that, as explained below, an embodiment of the invention as described by claims 58 and 59 is provided by Example 4 of the specification at pages 54-55.

Claims 62 and 63 recite SEQ ID NO:5 and SEQ ID NO:10. Support for these sequences is found in Example 4, pages 54-55 of the specification. As discussed therein, a human cDNA library was probed with full-length rat Semaphorin W cDNA. A human cDNA sequence that hybridized to the probe was isolated and designated clone #103. The nucleotide sequence of clone #103 was determined to be SEQ ID NO:10 at the 5' end of the clone and SEQ ID NO:5 at the 3' end of clone. As disclosed in the Sequence Listing, SEQ ID NO:5 is made up of 1761 nucleotides, and SEQ ID NO:10 is made up of 333 nucleotides. As further discussed in Example 4, SEQ ID NO:10 encodes 111 contiguous amino acids, while SEQ ID NO:5 encodes 587 contiguous amino acids. The polynucleotide of SEQ ID NO:10 can be operatively linked to the polynucleotide of SEQ ID NO:5 in the 5' to 3' direction to form an open reading frame that encodes a human semaphorin W protein as exemplified by clone #103.

Applicants respectfully submit that the pending claims fully comply with 35 U.S.C. § 112, first paragraph, written description. Accordingly, withdrawal of the instant rejection is therefore respectfully requested.

Claims 51-52

Claims 51 and 52 are rejected under 35 U.S.C. § 112, first paragraph for allegedly containing new matter. Claims 51 and 52 are canceled, thus rendering the rejection moot. It should be noted

that Applicants do not agree that the canceled claims fail to meet the requirements of 35 U.S.C. § 112, first paragraph. However, these claims are canceled in order to obtain immediate allowance of the present application.

**Conclusion**

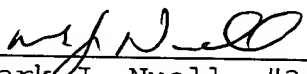
Applicants respectfully submit that all of the outstanding issues precluding allowance of the present application have been addressed and overcome by Applicants, such that the present application is now in condition for allowance. The favorable action of allowance of all of the pending claims is respectfully requested.

If there are any minor matters precluding allowance of the application which may be resolved by a telephone discussion, the Examiner is respectfully requested to contact Kristi L. Rupert, Ph.D. (Reg. No. 45,702) at (703) 205-8000.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of three (3) months to November 15, 2003, in which to file a reply to the Office Action. The required fee of \$950.00 is enclosed herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,  
BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
Mark J. Nuell, #36,623

  
DRN/KLR  
0020-4546P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000